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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,743	01/10/2001	Jorg Kleiber	1803-337	1340
7590 02/11/2004				
PENNIE & EDMONDS LLP 1155 Avenue of the Americas New York, NY 10036-2711		EXAMINER NAFF, DAVID M		
		ART UNIT PAPER NUMBER		
		1651		
DATE MAILED: 02/11/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/756,743

**Applicant(s)**

KLEIBER ET AL.

**Examiner**

David M. Naff

**Art Unit**

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-18 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/952,969.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/6/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for  
5 continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/6/03 has been entered.

The submission contained an Information Disclosure Statement and  
10 did not amend the claims.

Claims 13-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8 (filed 4/29/02).

15 Claims examined on the merits are 23-28.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Specification***

The disclosure is objected to because of the following  
20 informalities: the abstract is not sufficiently descriptive of the disclosure. The following abstract is suggested ---

Magnetic glass particles are prepared containing a magnetic core coated with a glass layer having a substantially pore-free glass surface or having pores with a diameter of less than 10 nm. The  
25 particles are used for separating biological material such as nucleic

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acids. A preferred process of preparing the particles is by forming a mixture of magnetic cores with a sol formed from an alcohol and a metal alkoxide, spray-drying the mixture to coat the cores with a layer of gelled sol, and heating the coated cores to obtain the

5 magnetic glass particles. Preferably, the particles have an average particle size of less than 100  $\mu\text{m}$ . The magnetic core may be a composite material containing a mica core and magnetite particles immobilized on the mica core, and the glass layer may contain boron oxide. Magnetic core materials include magnetite ( $\text{Fe}_3\text{O}_4$ ) and  $\text{Fe}_2\text{O}_3$ . ---

10 .

Appropriate correction is required.

#### ***Claim Objections***

Claims 23-28 are objected to because of the following informalities: in line 7 of claim 23, "pore free" should be changed

15 to --- pore-free --- to be consistent with the recitation of this term in the specification (page 2, penultimate line).

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as

20 being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 2, the claim is unclear as to whether the sample is that of claim 1 or some other sample. To be clear that the sample is that

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of claim 1, it is suggested that --- the --- be inserted before "sample".

### ***Double Patenting***

Claims 23-28 are rejected under the judicially created doctrine  
5 of obviousness-type double patenting as being unpatentable over claims  
1-11 of U.S. Patent No. 6,255,477 B1. Although the conflicting claims  
are not identical, they are not patentably distinct from each other  
because the presently claimed method of separating nucleic acids using  
a magnetic particle having a magnetic core and boron oxide-containing  
10 glass outer layer that can have pores with a diameter of less than 10  
nm would have been obvious from the claims of the patent claiming a  
method of making magnetic glass particles having a magnetic core and  
glass outer layer which can contain boron oxide and have pore  
diameters of less than 10 nm, and claiming a method of using the  
15 particles to separate biological material which can be a nucleic acid.

### ***Double Patenting***

Claims 23-28 are rejected under the judicially created doctrine  
of obviousness-type double patenting as being unpatentable over claims  
1-27 of U.S. Patent No. 6,562,568 B1 in view of claims 1-11 of U.S.  
20 Patent No. 6,255,477 B1.

The claims of the '568 patent require a process of isolating a  
nucleic acid with magnetic glass particles which can contain boron  
oxide (claim 5) by binding the nucleic acid to the particles,  
separating the bound nucleic acid from unbound nucleic acid and  
25 eluting the nucleic acid from the particles.

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The methods of the claims of the '477 patent are described above.

It would have been obvious to use as the magnetic glass particles of the claims of the '568 patent, the magnetic glass particles produced by the method of the claims of the '477 patent since these  
5 magnetic glass particles would have been expected to be effective for separating a nucleic acid.

The claims are free of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Naff  
10 whose telephone number is 571-272-0920. The examiner can normally be reached on Monday-Friday 9:30-6:00.

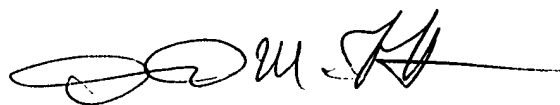
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this  
15 application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for  
20 unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'DMN' followed by a stylized flourish.

David M. Naff  
Primary Examiner  
Art Unit 1651

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DMN  
2/6/04